

### **REMARKS**

Claims 16-30 are pending in the instant application. This Amendment, which amends claims 16 and 29 and cancels claims 23 and 24, is submitted in response to the Office Action of June 27, 2007. No new matter has been added by these amendments.

The Office Action has rejected all pending claims under 35 U.S.C. §§ 102 and 103, and also asserted a provisional non-statutory double patenting rejection. Based on the foregoing amendments and below remarks, Applicants respectfully request that the rejections be reconsidered and withdrawn.

### **Rejections Under 35 U.S.C. § 102**

Claims 16-24 and 28-30 have been rejected under 35 U.S.C. § 102 as purportedly being anticipated by Von Arx (U.S. Pat. No. 2,554,133), Afromowitz (U.S. Pat. No. 4,627,172), Levrero (U.S. Pat. No. 2,627,666), or Augustino (U.S. Pat. No. 7,051,451). Applicants respectfully submit that, at a minimum, the claimed invention is novel over each cited reference because each cited reference fails to teach the connector recited in the claims as amended.

Specifically, claims 16-21 have been rejected as being anticipated by Von Arx. Claim 16 has been amended to recite the limitations contained in claims 23 and 24, which previously depended from claim 16 and are now cancelled. The Examiner did not reject claims 23 and 24 in view of Von Arx. Since Von Arx does not teach the connector limitation recited in the amended claims, Von Arx fails to teach each and every limitation recited in claim 16, or claims 17-21, which depend from claim 16. For this reason, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 16 and 28 have been rejected as being anticipated by Afromowitz. The Examiner also did not reject claims 23 or 24 in view of Afromowitz. Since Afromowitz does not teach the connector limitations recited in claim 16, as amended, or claim 28, which depends from claim 16, Afromowitz fails to teach each and every limitation recited in claims 16 or 28. Additionally, Afromowitz does not teach the claimed plumb bob. Afromowitz is directed to an inclinometer that is damped. The inclinometer uses a cylindrical weight [22] that is hung from a rod [12] (column 1, lines 18-21; column 2, line 67 to column 3 line 3). However, Afromowitz does not specifically teach using a plumb bob. The disclosed cylindrical weight [22] is not a plumb bob, nor is it an obvious variant of a plumb bob. For

these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 29 and 30 have been rejected as being anticipated by Levbrero. Levbrero also fails to teach the connector recited in claims 29, as amended, or in claim 30 *vis-à-vis* its dependency on claim 29. Additionally, Levbrero fails to disclose the claimed plumb bob. Levbrero is directed to a gradient indicating level comprising a tubular member [7] that pivots along a first axis and a drum [15] having an eccentric weight that pivots along a second axis that is orthogonal to the first axis (column 1, lines 14-42; column 2, lines 32-42; column 2, line 56 to column 3, line 6). The combination of a tubular member and a drum is not a plumb bob. For these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 16-24 have been rejected as being anticipated by Augustino. Augustino is directed to a measurement tool for caudal facet joint prosthesis. In Figures 8a through 9d, Augustino discloses a stem element [701]. However, the Augustino stem element has a screw or fastener [703] that is loosened in order to position the stem at the appropriate angle. After the appropriate angle is set, the screw is tightened, preventing the stem from moving (column 9, lines 56-60). Thus, the Augustino stem does not hang under the influence of a local gravitational field because the screw prevents it from hanging. Therefore, Augustino fails to teach each and every element of the claimed invention.

Additionally, Augustino does not teach a connector. Augustino discloses a measurement tool that has "a measurement tool holder including a measurement surface connected to a holder element." (column 4, lines 42-44). The measurement tool holder [800] includes a measuring surface [801] and a holder element [802]. The measurement tool holder of Augustino may include markings to assist in obtaining the desired angle measurement. (column 9, lines 28-30). As evident in Figs 9A-9D, the measurement tool holder is the body of the gauge. Therefore, Augustino's measurement tool holder is not disposed on the body of the gauge because Augustino's measurement tool holder [800] is the body of the gauge.

Nor does Augustino's measurement tool holder connect to a prosthetic component of a predefined site of a patient. As evident in Figs 10A and 10B, the measurement tool is placed in a hole formed in the vertebra where the prosthesis is intended to be placed (column 9, lines 46-48). Therefore, it does not connect to any prosthetic component because it only connects to the vertebrae. Furthermore, in order for the

measurement tool to be placed into the hole formed in the vertebra, the measurement tool holder [800] cannot be attached because, as apparent in Figs 10A and 10B, the measurement tool holder [800] would pose as an obstacle preventing the measurement tool from entering the hole in the vertebra. Thus, aside from the fact that there is no suggestion in Augustino of connecting the measurement tool holder to a prosthetic component of a predefined site of a patient, there is no means of using the measurement tool holder [800] when the measurement tool is measuring the angle in the vertebra. Instead, the measurement tool must be first removed from the hole in the vertebra before it can be joined with the measurement tool holder. Therefore, Augustino also fails to teach a connector as recited in the claims because the measurement tool holder does not connect the gauge to a prosthetic component.

For these reasons, Augustino fails to teach a plumb bob that hangs under the influence of a local gravitational field or a connector as recited in the claims. Thus, Augustino fails to teach each and every element of the claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

### **Rejections Under 35 U.S.C. § 103**

Claims 16 and 25-27 have been rejected under 35 U.S.C. § 103 as being unpatentable over Farmer (U.S. Pat. No. 5,141,512) in view of Augustino. The Office Action acknowledges that Farmer fails to disclose a plumb bob or a connector. Farmer's shortcomings are not overcome by Augustino, because Augustino also fails to disclose the claimed plumb bob or connector for the reasons discussed above.

In addition to these failures, there is no motivation or reason to combine Farmer with Augustino. A rejection under Section 103 must be supported by some reason for a skilled artisan to combine the elements in the same manner as the applicant. *KSR Int'l v. Teleflex*, 127 S.Ct. 1727, 1731, 82 U.S.P.Q.2d 1385 (U.S. 2007). The reason or motivation cited cannot be based on hindsight. MPEP § 2145. In this case, the cited reason to combine Farmer with Augustino improperly disregards the fact that Farmer and Augustino are directed to completely different problems. Farmer is directed to an apparatus for aligning an acetabular cup in a socket in a hip joint replacement. Augustino is directed to a tool to aid in the placement of facet joint prosthesis in the spine. There are considerable differences between aligning an acetabular cup in a socket in a hip and placement of facet joint prosthesis in the spine. Simply, the hip and the spine are structurally different to the point that there are completely different considerations when replacing a hip joint as opposed to placing a facet

joint prosthesis. Thus, a skilled artisan would not be motivated to combine an apparatus to be used in hip replacement surgery with an apparatus used for installing a facet joint prosthesis in the spine. As such, there is no motivation or reason to combine the references.

For these reasons, Applicants respectfully request that this rejection be reconsidered and withdrawn.

**Provisional Double Patent Rejection**

Claims 16-30 have been provisionally rejected as purportedly unpatentable over claims 161-193 in co-pending U.S. App. No. 10/494,085 ("the co-pending '085 application") on the grounds of non-statutory double patenting. As of the date of this Amendment, claims 161-193 in the co-pending '085 Application have not been allowed. As such, Applicants are not required to address this provisional rejection at this time, and will address this provisional rejection if and when claims 161-193 in co-pending '085 Application are allowed.

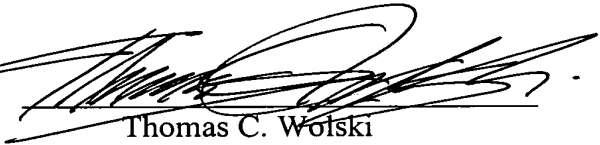
**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that all pending claims in the instant application are novel over the prior art and are in condition for allowance. Accordingly, reconsideration and withdrawal of the rejections and a Notice of Allowance are respectfully requested.

Should the Examiner have any questions or concerns, the Examiner is invited to contact Applicants undersigned attorney by telephone at 412-471-8815.

Respectfully submitted,

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